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REMARKS

Claims 1-3, 6, 7, 10, 11, 13-15 and 17-24 are pending, including independent claims 1, 2, 10-11 and 21-24, and the independent claims have been objected to for reciting "communications" rather than "communication". Applicant has amended the claims as required.

The claims remain rejected under 35 USC § 103(a) as being unpatentable over Wells (USPN 6846238).

In the rejection, the Examiner acknowledges that Wells fails to teach playing a game exclusively on a game play portion. This is because during remote play, the user is playing on the remote, mobile device. However, the Examiner asserts that such would be an obvious modification of Wells to allow the user to terminate a game on the mobile terminal and play on the game machine during local game play.

Applicant disagrees with the Examiner's reasoning because the Examiner does not provide any references to support the obviousness proposition. The Examiner's sole evidence is the disclosure of the pending application and not based on knowledge in the art so that it is inferred that improper hindsight reasoning is

applied. *In re Leonard R. Kahn*, 441 F.3d 997 (Fed. Cir. 2006) (it is inferred that hindsight reasoning is applied unless there is an explanation by the Examiner of the motivation or the suggestion or teaching of why the skilled artisan would combine the references to form the claimed invention); *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998)(requiring the Examiner to provide references that both teach the limitations in the claims and suggest combining their respective teachings "stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness"); *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (BPAI 1984) ("the art, without the benefit" of Applicant's specification, must provide the suggestion to "make the necessary changes in the reference device" and produce the claimed invention).

Moreover, the proposed modification exactly contradicts the purpose of the Wells invention which is solely directed to playing a game on a portable game station. Such purpose is inapposite with the purpose of the invention which is directed to enabling a person to play a game on a stationary game machine and which uses a mobile device *only* to enable the user to play on the stationary machine. Accordingly, such a modification of Wells to provide the claimed invention is not acceptable. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983) (a "reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed

invention"); *In re Leonard R. Kahn*, 441 F.3d 997 (Fed. Cir. 2006) (a reference teaches away when the skilled artisan would be "discouraged from following the path set out in the reference, or would be led in a direction divergent from the path taken by the applicant").

Although Applicant disagrees with the Examiner, Applicant has amended the independent claims to render the same patentable over the art. For example, the independent claims now recite (see e.g., Claim 24):

> "a control portion disposed on said game play portion said control portion identifying the user on the basis of the input of personal information by said mobile communication terminal, said control portion thereafter making a call to the Internet service provider;
>
> responsive to the user being on the lists of subscribers and said game start approval button being operated, said control portion actuating a game credit switch disposed within said game play portion to enable the game play by said game play portion so that said game play portion is operable without the use of coins".

The above operation of the invention is not disclosed in Wells so that the claims are patentable thereover. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.

Cir. 1991) (to establish a *prima face* case of obviousness, three basic criteria must be met: there must be a suggestion or motivation to modify the references to provide the claimed invention; there must be a reasonable expectation of successfully providing the invention as claimed; and *the references must teach all of the claimed limitations*).

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

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